

REMARKS

Presently, claims 1-27, 29-34, 36-54, 57-59, 63-68, 70-98, 100-113, and 118-121 are pending in the application.

Claim Rejection – § 103(a)

The Examiner has rejected claims 1-2, 20-27, 29-34, 36-56, 59-68, 100-113, and 118-121 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,909,837 to Unger *et al.* (“Unger”) in view of U.S. Patent No. 6,006,257 to Slezak *et al.* (“Slezak”). The Examiner contends that Unger discloses a method for displaying an alternative advertisement during a trick-play event, but acknowledges that Unger does not teach or suggest “a control means for ignoring the termination of trick play event mode during the recorded advertisement portion being viewed.” The Examiner further contends that Slezak teaches the features that Unger lacks, and concludes that it would have been obvious to combine the teachings of Slezak with Unger. Applicant respectfully traverses this rejection.

Unger teaches a method and system for providing alternative, less-intrusive advertising that appears during fast forward playback of a recorded video program. The system of Unger recognizes “tagged frames” and outputs these “tagged frames” during a fast forward operation to deliver an “abbreviated advertising message.” (See Unger, column 7, lines 14-22).

Slezak teaches that if a viewer is viewing a “must view” video segment and the viewer requests a “forward shift” or a channel change, “the process is waited until the current ‘must view’ video stream is completed...” (See Slezak, column 9, lines 38-57). Slezak’s invention is oriented towards preventing a viewer from fast forwarding a “must view” video segment.

Claim 1 recites:

A method for displaying an alternative advertisement to a subscriber during a trick-play event, the method comprising:

detecting the trick-play event during playback of a recorded advertisement;
displaying the alternative advertisement to the subscriber;
detecting an end of the trick play event prior to the end of the recorded advertisement;
continuing, until the end of the recorded advertisement, trick playing the recorded advertisement and displaying the alternative advertisement; and
returning to displaying a recorded programming at the end of the recorded advertisement.

The Examiner contends that the proposed combination results in “Unger with a control means as taught by Slezak for detecting an end of a trick play event and continuing the trick play of the recorded advertisement until the end of the recorded advertisement thereby enhancing the capacity of the apparatus of Unger in order to force a viewer to view a certain portion of the program.” (See Office Action, page 3). However, independent claim 1 does not recite displaying a “program”, but instead recites displaying “the alternative advertisement.” Therefore, even if the combination teaches what the Examiner argues, the combination still fails to teach all aspects of claim 1. Furthermore, Applicants disagree that the combination of Unger and Slezak would yield the result stated by the Examiner.

The Examiner seems to have misread the teachings of Slezak. The Examiner states that “Slezak teaches an apparatus comprise a control means for controlling viewing a portion of a program until the end of the portion by ignoring a termination of a current mode during viewing the portion input by a user.” This overstates the teachings of Slezak. Instead, Slezak states:

If the viewer is viewing a "must view" video, the process proceeds to step 2022 where it is determined whether the command requests a forward shift in the current video stream or an entirely new video stream. If command does request a forward shift or change from the current video stream, the process is waited until the current "must view" video stream is completed in step 2024. (Slezak, column 9, lines 50-56)

Accordingly, Slezak does not teach “ignoring a termination of a current mode during viewing the portion input by a user.” Rather, Slezak teaches that if the user wants to fast forward or change the channel during “must view” video, the process is waited until the current “must view” video stream is complete.

In the above quoted section, when Slezak teaches that the “process is waited,” it is not a trick play process that is being “waited.” Slezak instead detects an initiation of a fast forward command or a channel change, not “an end of the trick play event.” Therefore, Slezak cannot be said to teach “detecting an end of the trick play event prior to the end of the recorded advertisement;” and “continuing, until the end of the recorded advertisement, trick playing the recorded advertisement and displaying the alternative advertisement;” as recited in claim 1.

Additionally, Slezak teaches waiting for the “must view” video to play. In Slezak, the video that the user is viewing is completed, whereas, in claim 1, it is the video that the user is not viewing (i.e. the trick playing recorded advertisement) that affects the acknowledgement of trick play commands. In other words, Slezak waits until the end of the “must view” video. In contrast, claim 1, continues “until the end of the recorded advertisement, trick playing the recorded advertisement and displaying the alternative advertisement...”

Furthermore, Slezak does not teach “displaying the alternative advertisement” while continuing to trick play. Instead, Slezak teaches that “the process is waited until the current “must view” video stream is completed...” This is not for a trick play event, nor is it in response to the ending of a trick play event. Further, this is not an alternative video (derived from the underlying recorded advertisement) that is being played, but instead the “must view” video that is part of the original presentation stream.

Although the Examiner states that Unger only “fails to teach a control means for ignoring the termination of trick play event mode during the recorded advertisement portion being viewed,” Unger also fails to teach continuing to display the alternative

advertisement as recited in claim 1. Therefore, the combination of Unger and Slezak fails to teach all aspects of independent claim 1.

Independent claim 33 recites “displaying the alternative advertisement to the subscriber, wherein said displaying includes displaying the alternative advertisement if a determination is made that the alternative advertisement can be displayed within a time period needed to trick play through the remaining portion of the recorded advertisement.” However, in the Office Action, the Examiner does not even attempt to address whether making a determination if “the alternative advertisement can be displayed within a time period needed to trick play through the remaining portion of the recorded advertisement.” Additionally, Applicants submit that the Examiner’s February 26, 2007 Office Action contains an “error that affects applicant’s ability to reply to the Office action...” (MPEP 710.06). Specifically, the Examiner did not attempt to address all aspects of claim 33. Since the Examiner failed to properly address this claim, Applicants are unable to address any rejection of claim 33 that the Examiner might have. Therefore, Applicants believe that any potential subsequent Office Action should be non-final due to the Examiner’s failure to read the Applicants’ claims and address each and every one.

Moreover, Applicants respectfully submit that there is nothing in the prior art of record that teaches making a determination if “the alternative advertisement can be displayed within a time period needed to trick play through the remaining portion of the recorded advertisement,” as recited in claim 33. Neither Unger, Slezak, nor the combination thereof teach or suggest determining the time period needed to trick play through the recorded advertisement and whether the alternative advertisement can be displayed during that period. Therefore, Applicant believes claim 33 to be patentable over the proposed combination of Unger and Slezak.

Independent claim 36, recites “pausing the trick play event until said displaying alternative advertisement is complete if additional time is required to display entire alternative advertisement based on the point in advertisement that the trick play event occurs.” Independent claim 63 recites, “means for automatically controlling the fast forward event, wherein if said means for detecting detects the end of the fast forward

event prior to end of the recorded advertisement, said means for automatically controlling will continue to fast forward the recorded advertisement until the end of the recorded advertisement, and said means for displaying will continue to display the alternative advertisement until the end of the recorded advertisement.” For similar reasons as discussed in relation to claim 1, independent claims 36 and 63 are believed to be patentable over the combination of Unger and Slezak.

Claims 2, 20-27, 29-32, 34, 37-54, 59, and 64-68 are allowable at least by their dependence on claims 1, 33, 36, and 63, respectively. The Examiner has again rejected 55-56, and 60-62, even though these claims have been previously cancelled. Therefore their rejection is moot. Reconsideration and withdrawal of the Examiner’s rejection of claims 1-2, 20-27, 29-34, 36-56, 59-68, 100-113, and 118-121 are respectfully requested.

The Examiner has rejected claims 3, 4, 7-14, 17-19 and 57-58 under 35 USC § 103(a) as being unpatentable over Unger in view of Slezak and in further view of U.S. Patent No. 4,845,564 to Hakamada et al. (“Hakamada”). Applicants believe that Hakamada does not teach any of the aspects of claims 1 and 63 that the combination of Unger and Slezak fails to teach. Accordingly, Applicants submit that independent claim 1 is allowable over the combination of Unger, Slezak, and Hakamada. Dependent claims 3, 4, 7-14, 17-19, and 57-58 are believed to be allowable at least due to their dependence on claim 1 and 63, respectively. Reconsideration and withdrawal of the Examiner’s rejection of claims 3, 4, 7-14, 17-19 and 57-58 are respectfully requested.

The Examiner has rejected claims 5, 6, 15 and 16 under 35 USC § 103(a) as being unpatentable over Unger in view of Slezak, in further view of Hakamada, and further in view of U.S. Patent 5,031,044 to Canfield et al. (“Canfield”). Applicants believe that Canfield does not teach any of the aspects of claim 1 that the combination of Unger, Slezak, and Hakamada fails to teach. Accordingly, Applicants submit that independent claim 1 is allowable over the combination of Unger, Slezak, Hakamada, and Canfield. Dependent claims 5, 6, 15, and 16 are believed to be allowable at least due to their dependence on claim 1. Reconsideration and withdrawal of the Examiner’s rejection of claims 5, 6, 15 and 16 are therefore respectfully requested.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that the Examiner's rejections have been overcome, and that the application, including claims 1-27, 29-34, 36-54, 57-59, 63-68, 110-113, and 118-121, is in condition for allowance. Reconsideration and withdrawal of the Examiner's objection and a Notice of Allowance is respectfully requested.

Respectfully submitted,

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